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| 09 897,235      | 07 02 2001  | Stephen P. Norton    | 00774               | 8213             |

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EXAMINER

HESS, DANIEL A

ART UNIT PAPER NUMBER

2876

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/897,235

Applicant(s)

NORTON, STEPHEN P.

Examiner

Daniel A Hess

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. Receipt is acknowledged of an amendment on 4/30/2003, which has been entered into the file of record, and to which this action is a reply.

### *Remarks*

2. The rejection of the earlier action of 1/31/2003 is being maintained, and as a result, this action is being made final. In particular, note the *Response to Arguments* section below, after the rejections are made, which gives in detail the reasons that the examiner is maintaining the rejection. Also, note Nagata et al. (US 4,677,657), which clearly shows a card in which the contacts are on the rear side. Note especially figure 2. This art is not relied upon, but could clearly be used as a 102 rejection.

3. The applicant emphasized the criticality of having an uninterrupted surface for indicia and the like. The examiner notes, however, that in the event that the front surface contains contacts, the back surface is then an uninterrupted surface for indicia.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 2, 3, 6-9, 11-21, 25-28, and 31-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilsner, Tutorials in 1999: Smart Cards (of record in IDS).

Re claims 1, 2, 3, 8, 9, 18-21, 27-28 and 31-38: Kilsner shows (p. 1, figure 1) a smart card that has indicia and an ISO-type contact. There are all the various electronic components claimed (p.2; also, figure 4).

What Kilsner fails to show is that the indicia and the ISO-type contact are on opposite sides of the card. However, this is a matter of obvious design choice: such an arrangement affects only the appearance of the card.

One would have been motivated to place the indicia and contact on opposite sides if, for example, the front indicia of Kilsner would be more visually appealing without it. This is clearly shown in the case of many common credit cards and debit cards, where the magnetic stripe is on the rear face, so as not to interfere with the design on the front.

Re claim 6 and 25: Such a voltage level is understood to be standard within the art for such electronics.

Re claim 7 and 26: It is old and well-known in the art to use a magnetic stripe in credit/debit cards for easy use in places such as retail stores. In view of this it would have be obvious to include a stripe on the card of Kilsner in the back as taught be common credit or debit cards in order to permit the card to have the further use of enabling credit or debit transactions.

Re claims 11-17: Kilsner notes (first line) that a smart is "very similar in size to today's plastic credit cards." It is also well known that they are normally made of some type of plastic like that claimed.

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Re claims 19 and 39-41: The existence of a card with a contact on the back implies a reader that can interface with it. It is standard in the art to convey power through the contacts; Kilsner's card shows no contact.

6. Claims 4, 5, 22, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilsner as applied to claim 1 above, and further in view of Saitoh (US 5,929,414), of record (IDS). The teachings of Saitoh have been discussed above.

Kilsner fails to show non-contact means on a card.

Saitoh teaches a card having both contact and non-contact means as well as a card reader that have both contact and non-contact means (see entire document; column 3, lines 52-58).

In view of Saitoh, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known to non-contact means including the antenna enclosed internally as taught by Saitoh into the teachings of Kilsner because this enables both versatility / use with both contact and non-contact cards/reads.

7. Claims 10, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilsner as applied to claim 1 above, in view of Jachimowicz et al. (US 5,789,733), of record (IDS).

Kilsner fails to show a smart card with an optical transmitter/receiver system.

Jachimowicz shows (abstract, column 1, line 60-column 2, line 20; whole document) an optical transmitting and receiving system on a smart card.

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In view of the teachings of Jachimowicz, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known to include the optical transceiver as taught by Jachimowicz in the teachings of Kilsner because this can permit very rapid/high bandwidth data exchange between the card and the reader, faster than is typically possible electrically.

### ***Response to Arguments***

8. Applicant's arguments filed 4/30/2003 have been fully considered but they are not persuasive.

9. The applicant has argued, in essence, that placing a contact on the rear of the card is not a matter of design choice, because there is a particular motivation for this arrangement. But designs typically have some reason. The examiner notes that since, even with the contacts on the front, it is possible to have indicia and graphics, the placement of contacts on the back is not critical for functioning. One might observe, that placing the contact in the front leaves more room in the rear of the card for indicia.

10. The examiner believes he has provided a reason for placing the contact on the rear of the card, namely the aesthetic and design reasons of a credit card with the magnetic stripe on the back. The parallels between a magnetic strip and smart card-type contacts are clear. Both are machine-readable card markings. One who notes that a credit card stripe is 'hidden away' on the back side would be motivated to do the same with another machine-readable marking. Why? For additional room and aesthetics, as was noted.

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11. Nagata (figure 2) provides good support for this as the stripe and contacts are *together* located on the back side, both hidden away!

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. As has been noted above, Nagata et al. (US 4,677,657) clearly shows (figure 2) a contact on the back of a card. This claims priority to an application going back to 1984.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

15. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DH  
May 13, 2003

Daniel A Hess  
Examiner  
Art Unit 2876



DIANE I. LEE  
PRIMARY EXAMINER